Please amend the Claims as follows:

N.E. Claims cancelled in Amdt D.

Please cancel Claims 8-17 without prejudice.

Remarks

Claims 1, 2 and 4-7 are under consideration in this case. A list of these claims is enclosed as an appendix for the Examiner's convenience.

As the only bar to allowance of the present claims, the Examiner has maintained that the pending claims should be rejected under 35 U.S.C. § 102(a) over Saito et al., Mol. Cell. Neurosci. 6(3):280-92 (1995) (Saito). Applicants wish to point out that no such rejection has been officially stated, such rejection having only been stated "in *arguendo*" (*see* page 3, paragraph 8 of Office Action mailed June 25, 1998).

Saito was published within a year of the filing of the present application. An "In re Katz" declaration has been filed concerning the authors of the Saito paper, and therefore, Saito should be removed as a reference.

The Examiner bases the 35 U.S.C. § 102(a) rejection on the fact that the provisional application (Ser. No. 60/023,280, filed July 25, 1996 , now abandoned) to which the present application claims priority has more inventors listed than the present application, therefore different inventive entities are cited for the present invention. However, this conclusion does not logically arise from the present facts.

Section 2137.01 of the MPEP states, "The inventive entity for a particular application is based on some contribution to at least one of the claims made by each of the named inventors." However, because provisional applications frequently do not have claims, as is the case here, the inventors must only have made a contribution to the

matter disclosed (*see* 37 C.F.R. §1.45(c) and MPEP §605.07). Therefore, the concept of inventorship is different between provisional and non-provisional applications and a proper determination of inventorship in the legal sense can only be made once there is claimed subject matter.

The Examiner cites the Declaration of David Anderson, submitted in accordance with In re Katz, as contradicting the provisional application. The Declaration states that the contribution of Greenwood and Sun did not rise to the level of inventorship for the present application, i.e., for the invention described in the presently pending claims. Since there are no claims in the provisional, this is not contradictory.

The provisional application had no claims, and no Declaration/oath was ever filed attesting to the inventorship of any specified invention. Therefore, the Declaration of Anderson and the inventorship of the present application are not contradictory to the provisional application. For these reasons, Claims 1, 2 and 4-7 are not anticipated by Saito et al. under 35 U.S.C. § 102(a).

Because the foregoing is true, Applicants see no reason to re-open the abandoned provisional application to change its inventorship. The requirements to delete inventors include statements about the claimed subject matter. However, there is no claimed subject matter in the provisional. As Applicants have demonstrated, the inventorship of the present application, based on the claimed invention, is believed at this time to be correct and supported by the record which shows that the contributions of Greenwood and Sun did not rise to the level of inventorship.

In light of the above remarks, Applicants submit that the present application is in

condition for allowance and respectfully request early notification of such.

Respectfully Submitted,

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Dated: 9/21/99

APPENDIX--

1. (Amended) An isolated nucleic acid encoding a DRG11 protein, wherein said nucleic acid hybridizes under high stringency conditions to a complement of a nucleic acid molecule having a sequence as set forth in SEQ ID NO:1, and wherein said DRG11 protein is characterized by its natural expression in sensory neurons and dorsal horn neurons of the spinal cord and wherein its natural expression is absent in non-neuronal cells, sympathetic neurons and ventricular neurons of the spinal cord.

2. (Twice Amended) An isolated nucleic acid according to claim 1 encoding the amino acid sequence depicted in Figure 3 (SEQ ID NO:2).

4. (Twice Amended) An isolated nucleic acid according to claim 1 comprising the nucleic acid depicted in Figure 2 (SEQ ID NO:1).

5. (Amended) An isolated nucleic acid according to claim 1 operably linked to an expression vector comprising transcriptional and translational regulatory DNA.

6. A host cell transformed with an expression vector according to claim 5.

7. (Amended) A method of producing a DRG11 protein comprising:

a) culturing a host cell transformed with an expression vector comprising a nucleic acid according to claim 1; and

b) expressing said nucleic acid to produce a DRG11 protein.